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WILLIAM E HEIN
PO BOX 335
LOVELAND, CO 80539-0335

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OFFICE OF PETITIONS

In re Application of
Barth et al.
Application No. 10/808,050
Filed: March 24, 2004
Attorney Docket No. 503

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: DECISION ON PETITION
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This is a decision on the "PETITION IN RESPONSE TO NOTICE OF OMITTED ITEM(S)" filed September 28, 2004. Applicants petition to maintain the original March 24, 2004 filing date of the above-identified patent application with figures 10A and 10B as part of the original application disclosure.

Application papers in the above-identified application were filed on March 24, 2004. However, on July 28, 2004, the Office of Initial Patent Examination mailed applicants a "Notice of Omitted Items in a Nonprovisional Application." Applicants were notified that the application papers had been accorded a filing date; however, figures 10A and 10B appeared to have been omitted.

In response, applicants timely filed the instant petition (and petition fee). Applicants contend that the application as filed on March 24, 2004, included 67 sheets comprising 50 sheets of specification, claims and abstract, 14 sheets of drawings, and 3 sheets of Declaration as filed in grandparent application Serial No. 09/583, 381. In support thereof, applicants submit a copy of the postcard accompanying the above-identified application.

The application file is the Official record of what was received in the Office in an application. A review of the instant application file reveals that figures 10A and 10B were not among the papers filed on March 24, 2004, as figures 10A and 10B are not present in the application file.

Petitioner has not submitted persuasive evidence to support a contention that figures 10A and 10B were among the papers filed on March 24, 2004 (e.g., itemized postcard receipt), but not present in the application file because they were misplaced in the Office. As stated in MPEP 503, a postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application"

will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

Petitioner's return postcard has been reviewed, and found not to be persuasive evidence of receipt of figures 10A and 10B. Thereon, petitioner identifies "67 SHEETS OF SPECIFICATION, CLAIMS, ABSTRACT, DRAWINGS AND DECLARATION" as being among the papers filed. This description does not adequately itemize the components being submitted. This description does not allow for the acknowledgment of receipt of each component of the application on filing.

Accordingly, the petition is **DISMISSED**. The request for refund of the petition fee is denied. The petition fee is required, since the petition was not necessary to correct any error on the part of the Office.

Nonetheless, petitioners may seek to amend the application to include figures 10A and 10B¹. The application transmittal included an incorporation by reference of prior application No. 10/200,265. MPEP 201.06(c) states that:

If a continuation or divisional application as originally filed is entitled to a filing date despite the omission of a portion of the prior application(s), applicant will be permitted to add the omitted material by way of an amendment provided a statement was included in the application as originally filed that incorporates by reference the prior application(s). If the application as originally filed includes a proper incorporation by reference of the prior application(s), an omitted specification page(s) and/or drawing figure(s) identified in a "Notice of Omitted Item(s)" may be added by amendment provided the omitted item(s) contains only subject matter in common with such prior application(s). In such case, applicant need not respond to the "Notice of Omitted Item(s)." Applicant should submit the amendment adding the omitted material prior to the first Office action to avoid delays in the prosecution of the application. See MPEP § 601.01(d) and § 601.01(g).

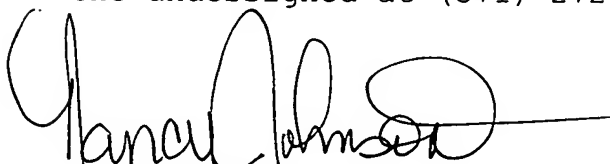
Obviously, in view of the incorporation by reference of the prior application, figures 10A and 10B are not new matter if they were a part of the disclosure of the prior application.

¹ Petitioners are reminded with respect to applications filed on or after September 21, 2004, 37 CFR § 1.57 has been added to provide for incorporation by reference. See *Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan; Final Rule*, 69 FR 56482, 56539 (September 21, 2004).

Thus, a preliminary amendment to amend the specification to include figures 10A and 10B should be filed prior to the first Office action on the merits to avoid further delay in the prosecution of this application. This amendment will be considered by the primary examiner.

The application is being returned to the Office of Initial Patent Examination for completion of pre-examination processing, with a filing date of March 24, 2004, using the papers received in the Office on that date.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions